

REMARKS

Applicant thanks the Examiner for acknowledging Applicant's claim to foreign priority under 35 U.S.C. § 119(a)-(d), and for confirming that the certified copy of the priority document has been received at the Patent Office.

Drawings:

Applicant thanks the Examiner for indicating that the Request for Approval of Proposed Drawings Changes submitted on June 25, 2001 have been approved.

Specification:

Applicant notes that the Examiner has not re-asserted the objection of the specification, set forth in the Office Action dated February 28, 2001, because of the form of the Abstract, and as such, Applicant assumes that the replacement Abstract filed on June 25, 2001 has obviated the Examiner's concerns.

Allowable Subject Matter:

Applicant again thanks the Examiner for indicating that claims 8 and 11 are allowable, if written in independent form. However, rather than writing these claims in independent form, Applicant respectfully traverses the rejections of their base independent claims, as set forth below.

Claim Rejections:

Claims 1-20 are all the claims pending in the application, and claims 1-7, 9-10 and 12-20 stand rejected.

35 U.S.C. § 112, 1st Paragraph Rejection - Claims 19-20:

Claims 19-20 stand rejected under 35 U.S.C. § 112, 1st paragraph as containing subject matter not contained in the specification.

Applicant has amended claim 19, as shown in the attached Appendix, to make it clear that the apparatus contains a “means for performing” a power control algorithm, as recommended by the Examiner. Applicant submits that this amendment adequately addresses the Examiner’s first concern regarding these claims.

However, regarding the Examiner’s assertion that “in the specification it is not described that the algorithm is de-activated by the presence of a second parameter”, Applicant respectfully disagrees. *See* Office Action dated July 16, 2001, page 2, para. 2 (emphasis omitted). The specification clearly states that the “second parameter” dictates whether or not the power control algorithm is to remain activated or be deactivated. *See e.g.* page 7 of the specification. The “second parameter” can, in certain embodiments, be a constant which could be environmentally dependent. *See id.* at lines 35-36. Thus, without the “presence” of such a parameter the present invention would not be able to determine whether or not the algorithm should be deactivated or not. Alternatively, without the “presence” of the estimated value of, for example, the “deviation value” the present invention would also not operate as claimed. Therefore, for at least these reasons, Applicant respectfully submits that the Examiner has failed to satisfy the burden of showing that persons of ordinary skill in the art would not recognize that the Applicant was in possession of the invention as claimed in claims 19 and 20, at the time the application was filed. *See* MPEP § 2163.04. Further, Applicant submits that one of ordinary skill in the art would

recognize that the Applicants' were in possession of the invention as claimed in claims 19 and 20, at the time the application was filed, because in at least some of the embodiments contemplated by the present invention, it is the "presence" of the second parameter which allows the invention to function.

35 U.S.C. § 102(e) Rejection - Claims 1, 3-7, 10, 14, and 19-20:

Claims 1, 3-7, 10, 14 and 19-20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,185,432 to Vembu et al. In view of the following discussion, Applicant respectfully disagrees.

As stated in the Applicant's Amendment, filed June 25, 2001, in the Vembu system the signal-to-noise ratio (SNR) is detected and used to determine which control mode is to be triggered, either a burst or tracking mode. When the SNR is at the proper level, nothing is done, when the SNR is high the signal is adjusted down, and when the SNR is low the control algorithm determines if a quick burst of signal is needed (burst mode) or a gradual increase is needed (tracking mode). However, in Vembu, unlike the present invention, the control algorithm is operating at all times. This is very similar to the prior art already discussed in the present application, where the control algorithm is constantly on and constantly adjusting the signal. As stated in the present application, this is not desirable as sometimes it is more efficient to not adjust the signal as triggered by the control algorithm. At no point does Vembu discuss or disclose de-activating the control algorithm to optimize the system performance. Vembu only discloses continuously operating the control algorithm to switch back and forth between different types of control modes, but at all times the control algorithm is operating.

The Examiner asserts that, in Vembu, it is either the burst mode algorithm or tracking mode algorithm which is the “power control algorithm” that is deactivated when an estimated value is detected. Applicant respectfully disagrees. Vembu does not disclose that either the burst mode or tracking mode are separate operating power control algorithms. Vembu only discloses that these are “modes” of a single algorithm. In fact, at col. 7, lines 36-47, Vembu discloses that it is the “receiver 112” which “determin[es] whether or not the system is at, above, or below threshold and whether the system is operating nominally. In this embodiment, receiver 112 (112a, 112b) sends a command to transmitter 108 (108a, 108b) *instructing transmitter 108 to change modes when appropriate.*” (Emphasis added). Therefore, it is the receiver 112, and the transmitter 108, which determine whether or not the system is at threshold and whether or not the system is operating normally. There is no disclosure in Vembu that the control algorithm controlling the receiver 112 and transmitter 108 is ever de-activated based on the presence, or value, of a second parameter. Further, there is no disclosure that either the burst or tracking modes are “power control algorithms” as asserted by the Examiner, as “[i]t is up to the transmitter to decide what is acted upon or implemented.” *See* col. 7, lines 52-53.

Therefore, for at least the reasons stated above, Applicant respectfully submits that Vembu fails to disclose each and every feature of the present invention, as claimed in claims 1 and 19, and hereby requests the Examiner reconsider and withdraw the rejection of these claims under 35 U.S.C. § 102(e). Further, as claims 3-7, 10, 14 and 20 depend from these claims, respectively, these claims are also allowable at least by reason of their dependency.

35 U.S.C. § 103(a) Rejection - Claim 2:

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Vembu in view of U.S. Patent No. 5,982,760 to Chen. Since claim 2 depends upon claim 1 and since Chen does not cure the deficient teachings of Vembu with respect to claim 1, Applicant submits that claim 2 is patentable at least by reason of its dependency.

35 U.S.C. § 103(a) Rejection - Claims 9, 12-13, and 15-18:

Claims 9, 12-13, and 15-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Vembu in view of the Examiner's Official Notice. Since claims 9, 12-13 and 15-18 depend upon claim 1 and since the Examiner's Official Notice does not cure the deficient teachings of Vembu with respect to claim 1, Applicant submits that these claims are also patentable at least by reason of their dependency.

Conclusion:

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

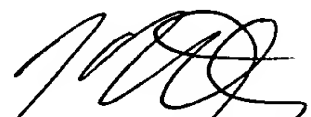
AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Appln. No. 09/287,264

Our Ref.: Q53917
Art Unit: 2682

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. 19-4880.

Respectfully submitted,

SUGHRUE, MION, ZINN,
MACPEAK & SEAS, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037-3213
Telephone: (202) 293-7060
Facsimile: (202) 293-7860



Terrance J. Wikberg
Registration No. 47,177

Date: October 5, 2001

APPENDIX
VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

The claims are amended as follows:

19. (Amended) An apparatus for improving performances of a mobile radiocommunication system, comprising:

a receiver; and

a means for performing a power control algorithm, said power control algorithm monitoring a first parameter received by said receiver for controlling said power control algorithm;

wherein said power control algorithm is de-activated by the presence of a second parameter.